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EXAMINER

PEFFLEY, MICHAEL F

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3739

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/606,250
Filing Date: June 24, 2003
Appellant(s): GARABEDIAN ET AL.

Michael J. Bolan
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the appeal brief filed March 23, 2006, supplemented on October 27, 2006 appealing from the Office action mailed November 3, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,530,922	Cosman et al	3-2003
2002/0120261	Morris et al	8-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 23-27, 29, 33-39, 44, 48, 49 and 70-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cosman et al (6,530,922).

Claims 28 and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cosman et al ('922) as applied to the claims above, and further in view of Morris et al (2002/0120261).

(10) Response to Argument

1) Claims 35-38, 44, 48, 49, 72, 73 and 81

Applicant contends that Cosman specifically teaches away from the steps of sequentially delivering energy to tissue with a single probe in favor of using a plurality of probes that are simultaneously activated to create a single, large lesion. The point that Cosman is teaching the simultaneous delivery of energy to a plurality of probes is indisputable. However, the examiner maintains that while Cosman may teach and adamantly hold that the creation of a single, larger lesion with a plurality of simultaneously actuated probes yields a superior result, this teaching does not mitigate the fact that it is known to create a larger lesion through the use of serially or sequentially activated probes. Applicant has readily admitted at page 5, first full paragraph, of the Brief that it is known to create lesions using serially or sequentially activated probes. The examiner stands by the position that while Cosman may teach that it is preferable to create a single, large lesion using simultaneously activated probes, Cosman also teaches that it is known to create multiple lesions using serially or

sequentially activated probes. Cosman may teach that it is less desirable to use serially or sequentially activated probes, but it doesn't erase the fact that it is known or would be obvious to do so.

2) Claims 23-26, 29, 33, 34 and 78

Claim 23 specifically requires the same probe to be placed in different apertures to create first and second lesions. The examiner maintains that one of ordinary skill in the art would recognize that operating a single probe in a plurality of locations would be an obvious alternative to placing a plurality of probes and then activating the plurality of probes sequentially to create a plurality of lesions. As addressed in the previous section, the examiner maintains that while Cosman teach that it is more preferable to create one larger lesion with a plurality of simultaneously activated probes, it does not obviate that it is clearly known to those of ordinary skill in the art to serially or sequentially activate the probes to create a series of individual lesions.

3) Claims 70, 71, 74 and 75

These claims call for a cannula to provide the electrodes to tissue. Applicant contends that Cosman specifically teaches away from the use of a cannula to deliver multiple electrodes and has recited a particular passage from the patent to support this assertion. It is the examiner's position that the quoted passage is taken out of context. Cosman discloses the use of the stereotactic guide to deliver the plurality of electrodes to treat very large lesions of up to 4-6 mm and does teach that the device is preferable to "side-emitting" electrode devices. However, Cosman also specifically disclose an embodiment (Figure 7) that includes a sheath, or cannula, to deploy a smaller number

Art Unit: 3739

of electrodes to a tumor. As such, the examiner maintains that the use of a cannula to delivery the electrode(s) in Cosman does not render the device unsatisfactory for its intended purpose, as posited by the applicant, since Cosman clearly anticipate the use of the device in a variety of environments that would required alternate deployment means.

4) Claims 76, 77, 79 and 80

These claims recite an alignment device affixed to the skin of the patient. Applicant contends that Cosman teaches away from this since the small needles are directed into an organ, and if the alignment device were placed on the skin the needles would not be suitable for percutaneous treatment of tumors. The examiner disagrees. While Cosman specifically addresses the treatment of liver tumors, this is but an example. The Cosman reference states that the device is to treat tumors in any organ on a human body (col. 5, lines 65-67). Skin tissue is an organ of the body, and one of ordinary skill in the art would obviously recognize that tumors located just under the skin tissue (or within the skin tissue) may advantageously be treated with the Cosman device. Moreover, the examiner maintains that securing the device to the skin tissue to prevent movement during the procedure would be an intuitive and obvious consideration for the user of such a device. As such, the examiner maintains that the rejection of these claims is tenable.

5) Claims 28 and 40-43

Applicant has not substantively argued these claims other than to assert that the Morris reference does not overcome the deficiencies of the Cosman teaching. As

Art Unit: 3739

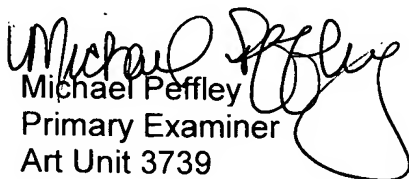
asserted previously, the examiner maintains that the Cosman teaching is not lacking in the relevant teaching that it is indeed known to sequentially activate the electrode members, regardless of the benefits Cosman discloses in activating the probes simultaneously. The examiner maintains that the combination of the Morris et al teaching with the Cosman reference is a tenable rejection.

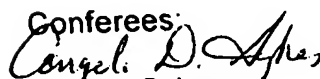
(11) Related Proceeding(s) Appendix

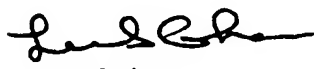
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Michael Peffley
Primary Examiner
Art Unit 3739

Conferees:

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